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Appl. No. 10/627,909

JUL 17 2006

REMARKS

Applicant respectfully requests reconsideration and continued examination of this application in view of the following remarks. Claims 1-19 are pending in this application.

Applicant thanks the Examiner for agreeing to review evidence of prior conception in a telephone call with Roger Masson, paralegal, on June 14, 2006 without a Request for Continued Examination.

1. Prior Art Rejections

Claims 1-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2005/0044792 to Beggs et al ("Beggs"). Claims 13-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Beggs in view of Thacker (U.S. Patent No. 6,359,564). Applicant respectfully traverses the rejections.

2. Beggs is Not Prior Art to the Present Application

Beggs is not prior art because Applicant is swearing behind Beggs by showing conception and reasonable diligence beginning before the filing date of Beggs, namely June 20, 2003 until the filing of the application and constructive reduction to practice by filing the application on July 25, 2003. Documentary evidence of a constructive reduction to practice is provided by the present patent application.

A. Applicant Conceived before June 20, 2003.

To demonstrate prior conception, Applicant has attached a Declaration under 37 C.F.R. § 1.131 of Robert S. Fielmann and a Declaration under 37 C.F.R. § 1.131 of Prior Conception of James D. Ryndak. Attached to the above Declarations is documentary evidence of prior conception. The first document is an opinion prepared before June 20, 2003 and signed by James D. Ryndak that describes the invention in the background section. The second document is a fax of drawings of the invention prepared by the inventor before June 20, 2003. Applicant submits that the above documents prove prior conception.

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B. Applicant's attorney was reasonably diligent in preparing the present application beginning before June 20, 2003 to filing of the application

To demonstrate attorney diligence, Applicant submitted to the USPTO Declarations under 37 C.F.R. § 1.131 of Roger M. Masson and James D. Ryndak on December 13, 2005. Although each case stands on its own facts, a review of cases is instructive. In *Poage v. Dyer*, 184 USPQ 223 (POBdInt 1974), the USPTO's Board of Interferences excused a 10-month delay in filing a patent application, because of other work and litigation. In *Emery, Howe and Marcella v. Ronden and Rabel*, 188 USPQ 264 (POBdInt 1974), the USPTO's Board of Interferences stated, "... it is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved" Cases where diligence has not been shown frequently are due to a failure to show with specificity what activities occurred and when. *E.g., In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing, but a mere pleading); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts).

The Declarations and attachments show that from June 2, 2003 to July 15, 2003, work was performed diligently on the subject patent application. On June 2, 2003, preparation of the patent application was discussed with R. Fielmann, inventor. Preparation of the patent application began on June 3, 2003. The work consisted of work actively occurring at least three times during a week. During the short periods of inactivity on the patent application, Messrs. Masson and Ryndak attended to many other pressing legal matters.

On July 15, 2003, the patent application and various formal papers were mailed to Mr. Fielmann, the inventor, for his review and approval. On July 21, 2003, Mr. Fielmann reviewed the patent application, signed the various formal papers, and mailed the application back to the law firm of Ryndak & Suri. Evidence of this is provided by the signed Declaration and Power of Attorney of the present application, which bears the date of "7/21/03." On July 25, 2003, the patent application was filed.


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The Declarations and exhibits show reasonable diligence beginning June 3, 2003 towards the filing of the present patent application. Applicant is only attempting to show reasonable diligence for a period of five weeks, not 10 months. Messrs. Ryndak and Masson have provided affidavits showing that they frequently worked on the present application and also worked on other pressing matters. Therefore, a showing of reasonable diligence has been made. Thus, Beggs is not prior art to the present application. Consequently, Applicant requests that all rejections based on Beggs be withdrawn.

CONCLUSION

In view of the foregoing, all of the rejections have been overcome and claims 1-19 are allowable over Beggs. An early indication of allowance is solicited.

Respectfully submitted,

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